

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 42

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAN KIKINIS

Appeal No. 2004-2274
Application 08/811,648

ON BRIEF

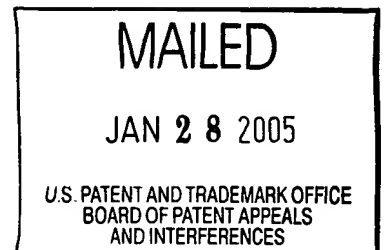
Before BARRETT, FLEMING, and MACDONALD, **Administrative Patent Judges.**

MACDONALD, **Administrative Patent Judge.**

REMAND TO THE EXAMINER

We remand this application to the Examiner for consideration of the following matters.

- I. Whether a rejection of claims 1-4, 7-9, and 14-17 under 35 U.S.C. § 112, first paragraph is appropriate.



II. The Dates The Examiner Accorded The Present Application
And The Applied Prior Art When Formulating The Rejections
Under 35 U.S.C. § 102 and 35 U.S.C. § 103.

**I. Whether A Rejection Of Claims 1-4, 7-9, and 14-17 Under
35 U.S.C. § 112, First Paragraph Is Appropriate.**

We have reviewed Appellants' specification as originally
filed and find subject matter in the claims before this Board
that fail to comply with the written description requirement.
The claims contain subject matter, which was not described in the
specification in such a way as to reasonably convey to one
skilled in the relevant art that the inventors, at the time the
application was filed, had possession of the claimed invention.

We discuss claim 1 as exemplary of the problems in claims 1
and 7. Claim 1 recites a "bridge adapter unit . . . having an
inlet port." We find no description indicating that micro-PBX
301 (the bridge adapter unit of claim 1) has the specific
structure of an inlet port. Claim 1 recites "a telephone wiring
structure . . . connected at a single point to an outlet port of
the bridge adapter unit." We find no description indicating that
micro-PBX 301 (the bridge adapter unit of claim 1) has the
specific structure of an outlet port. Further, we find no
description indicating that the telephone wiring structure is

connected at a single point. Claim 1 recites, "the bridge adapter unit drives the telephone wiring structure." We find no description indicating that the micro-PBX 301 performs the specific function of "driving" the telephone wiring structure. Claim 1 recites "the bridge adapter unit . . . translates all received public network protocol signals, regardless of protocol." Although the disclosure teaches that the micro-PBX 301 performs translation, we find no description indicating that the micro-PBX 301 performs the function of translating in such a universal manner.

Lastly and most importantly, claim 1 recites "the bridge adapter unit . . . modulates the signals in a manner to correct signal variations at the end points due to having multiple end points driven from a single point at the bridge adapter unit." We find no description indicating that this function is performed by any component in the original disclosure.

The record before us does not mention nor address these problems in any way. Therefore, we request that the Examiner take appropriate steps to address this issue.

Accordingly, we remand for consideration of this issue.

**II. The Dates The Examiner Accorded The Present Application
And The Applied Prior Art When Formulating The Rejections
Under 35 U.S.C. § 102 and 35 U.S.C. § 103.**

In the final rejection¹ the Examiner rejected claims 1-4, 7-9, and 14-17 of the present application filed **March 5, 1997**, under 35 U.S.C. § 102 and 35 U.S.C. § 103 as being anticipated by and obvious over Foley, U.S. Patent 6,069,899, filed **August 28, 1997**. We note that Foley, U.S. Patent 6,069,899, does not claim any continuity to an earlier filed U.S. patent or application.

The record before us does not mention nor address in any way the fact that the application that resulted in the Foley patent was filed after the application presently on appeal before this Board. Therefore, we request that the Examiner clarify the record and explain why Foley, U.S. Patent 6,069,899, is available as prior art to the present application.

Accordingly, we remand for consideration of this issue.

¹ Paper number 37.

Appeal No. 2004-2274
Application No. 08/811,648

Conclusion

If reconsideration by the examiner does not promptly result in the withdrawal of all pending rejections, the examiner must return this application to the jurisdiction of the board so that the appeal may be restored to its existing place in the order in which appeals are decided. In the event that the examiner returns this application to the jurisdiction of the board following reconsideration, a new appeal number will be assigned. However, a new appeal fee will not be required.

Appeal No. 2004-2274
Application No. 08/811,648

This application, by virtue of its Special status, requires *immediate* action by the examiner. See MPEP § 708.01(d). The Board of Patent Appeals and Interferences *must* be informed promptly of any action affecting the appeal in this case, including reopening of prosecution, allowance and/or abandonment of the application.

REMAND

Lee E. Barrett
LEE E. BARRETT

LEE E. BARRETT
Administrative Patent Judge

Michael P. Fleming
MICHAEL P. FLEMING

MICHAEL R. FLEMING
Administrative Patent Judge

Albert MacDonald

ALLEN R. MACDONALD
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Appeal No. 2004-2274
Application No. 08/811,648

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